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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,604	03/08/2004	Richard S. Bein	355492-2971	1765

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FOLEY & LARDNER LLP
1530 PAGE MILL ROAD
PALO ALTO, CA 94304

EXAMINER	
SAMALA, JAGADISHWAR RAO	
ART UNIT	PAPER NUMBER
1618	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/796,604	BEIN ET AL.	
	Examiner	Art Unit	
	Jagadishwar R. Samala	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/7/04 & 9/24/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election Restriction

1. Applicant's election with traverse of claims 1-16 in the reply filed on November 11, 2006 is acknowledged. The traversal is on the ground (s) that examining a composition suitable for use in embolizing blood vessels and a kit comprising an embolic composition and a catheter does not present the examiner with a search burden. This is not found persuasive because claims 1-16 and 22-23 differ in scope as indicated by their distinct modes of operation. As such, claims 22-23 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to a nonelected species and invention, there being no allowable generic or linking claims. Applicant's timely traversed the restriction (election) requirement in the reply filed on November 11, 2006. If the invention group I is found to be allowable, then the applicant can come for rejoining the group III. The requirement is still deemed proper and is therefore made FINAL.

Claims Disposition

2. Claims 1-16 are pending and under examination. Claims 17-23 are withdrawn.

Drawing

3. The drawing filed on March 08, 2004 has been acknowledged.

Information Disclosure statement

4. The Information Disclosure Statement filed on June 07, 2004 and September 24, 2004 has been received and entered. The references cited on the PTO-1449 Form have been considered by the examiner and a copy is attached to the instant Office Action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Evans et al. (US 6,342,202 B1 here after '202).

Claims 1-16 are drawn to a composition comprising a biocompatible polymer; a biocompatible solvent; and a water-insoluble, biocompatible contrast agent suitable for use in embolizing blood vessels.

The '202 patent discloses composition suitable for use in embolizing blood vessels. The composition comprises a biocompatible polymer, a biocompatible solvent and a water-insoluble contrast agent (see abstract). The composition comprising from about 2.5 to about 8.0 weight percent of polymers consisting of polyacrylonitrile, polyvinyl acetate, cellulose acetate and thereof (column 2, lines 60+). The polymer composition comprising from about 10-40 weight percent of water-insoluble contrast agent include tantalum, tantalum oxide, and barium sulfate of particle size of bout 10

microns or less (see column 3, lines 19-20 and 58-62). The biocompatible solvent of the composition is dimethylsulfoxide, analogues/homologues of dimethylsulfoxide, ethanol, acetone, and the like from about 52 to about 87.5 weight percent (see column 3, lines 21-22). The weight percent of the polymer, contrast agent and biocompatible solvent is based on the total weight of the complete composition. Therefore, all the critical elements as required by instant claims are taught by the cited reference and claims are anticipated.

3. Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Greff et al. (US 5,667,767 here after '767).

The '767 patent discloses composition suitable for use in embolizing blood vessels. The composition comprising a biocompatible polymer, a biocompatible solvent and a water-insoluble contrast agent (see abstract). The preferred biocompatible polymers is, ethylene vinyl alcohol copolymer, from about 2.5 to about 8.0 weight percent of the biocompatible polymer based on the total weight of the polymer composition (see column 3, lines 39-40). The polymer composition comprise from about 10-40 weight percent of biocompatible water-insoluble contrast agent includes tantalum, tantalum oxide, tungsten, and barium sulfate (see column 3, lines 41-44) and contrast agent particle size is about 1 to about 5 microns, preferably average size of about 2 microns (see column 5, lines 53-55). The biocompatible solvent of the polymeric composition is dimethylsulfoxide, analogues/homologues of dimethylsulfoxide from about 52 to about 87.5 weight percent based on the total weight of the composition (see column 3, lines 44-45). The weight percent of the polymer, contrast agent and

biocompatible solvent is based on the total weight of the complete composition. Therefore, all the critical elements as required by instant claims are taught by the cited reference and claims are anticipated.

Conclusion

1. No claims are allowed at this time.

2. Applicant's amendment necessitated the new ground (s) of rejection presented in this Office action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagadishwar R. Samala whose telephone number is (571)272-9927. The examiner can normally be reached on 8.30 A.M to 5.00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VICKIE KIM
PRIMARY EXAMINER

Jagadishwar R Samala
Examiner
Art Unit 1618

sjr